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| 10/007,899 | 11/05/2001 | Olaf Turner | P01,0332 | 3107 |
| 26574 | 7590 | 08/26/2005 | EXAMINER | |
| SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473 | | | CHEN, TSE W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2116 | |

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,899

Applicant(s)

TURNER ET AL.

Examiner

Tse Chen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 20, 2005 has been entered.

2. Claims 1-13 are presented for examination.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura, US Patent 5650974.

5. Yoshimura discloses an electronic device [10] comprising [fig. 1]:

- A security region [col.2, ll.13-31; col.8, ll.45-63; col.10, ll.17-24; comprising 3, 10a, and bat 2 associated with securely storing data but not with replacement accommodation such as battery holder] containing a plurality of security components [col.1, ll.16-25; memory 3 and associated components store personal data securely to prevent loss due to power disruptions].

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- A power source [101] adapted for connection to a means voltage [external power supply vcc] for normally supplying power to said security components [col.9, ll.18-22].
- A first battery [bat 2] disposed in said security region [col.2, ll.13-31; col.8, ll.45-63; bat 2 does not require a battery holder outside of security region as bat 2 is rechargeable within security region].
- A second battery [bat 1] disposed outside of said security region [col.2, ll.13-31; col.8, ll.45-63; bat 1 outside of security region in order to be accessed and replaced via battery holder] for supplying power to said security components upon an outage of said mains voltage [col.10, ll.45-51].
- A battery switchover device [10a] having a first input connected to said first battery and a second input connected to said second battery for switching power supply to said security components from said second battery to said first battery only if power from said second battery is absent [col.9, l.50 – col.10, l.24; col.10, l.51 – col.11, l.11].
- A monitoring unit [11] disposed in said security region and connected to said battery switchover device for evaluating voltage information associated with at least one of a voltage of said first battery and a voltage of said second battery [col.9, l.50 – col.10, l.16].

6. As to claim 5, Yoshimura discloses the battery switchover device that has an output [8] connected to components [memory 3] for supplying power thereto via said battery switchover device from one of said first power source and said second power source, and wherein said device further comprises, in said security region, decoupling elements [e.g., sw 1, 2] at said output.

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7. As to claim 6, Yoshimura discloses the decoupling elements that are selected from the group consisting of diodes [e.g., sw1] and controlled electronic switches [e.g., sw2].

8. As to claim 7, Yoshimura discloses the electronic device comprising a security module [10 sans battery holder] containing said monitoring unit and said security components [col.1, ll.22-25; integrated as a card].

9. As to claim 8, Yoshimura discloses the security module that comprises the battery switchover device [col.1, ll.22-25; 10 sans battery holder integrated as a card].

10. As to claim 9, Yoshimura discloses a battery compartment [27a] for said second battery, closeable with a battery compartment cover [27] [fig.5].

11. As to claim 10, Yoshimura discloses having a housing [of card] containing said security region and said battery compartment, and having a sidewall in which said battery compartment cover is disposed [fig.5; col.1, ll.22-25; 27 inserted into sidewall of card].

12. As to claim 11, Yoshimura discloses having a housing [of card] containing said security region and said battery compartment, and having a base in which said battery compartment cover is disposed [fig.5; col.1, ll.22-25; 27 inserted through base of card].

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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14. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura as applied to claim 1 above, and further in view of Wiley et al., U.S. Patent 6073085, hereinafter Wiley.

15. In re claims 2-3, Yoshimura discloses each and every limitation of the claim as disclosed above in reference to claim 1. Yoshimura did not disclose expressly an analog-to-digital converter for converting voltage information into digital information and the details of the monitoring unit.

16. As to claim 2, Wiley discloses an electronic device [electronic unit 50] comprising:

- A monitoring unit [CPU 111, battery circuit 131, A/D converter 115, etc.] that comprises an analog-to-digital converter [A/D converter 115] for converting said voltage information into digital information [col.5, ll.18-29].

17. It would have been obvious to one of ordinary skill in the art, having the teachings of Wiley and Yoshimura before him at the time the invention was made, to use the analog-to-digital converter taught by Wiley with the electronic device disclosed by Yoshimura as the analog-to-digital converter taught by Wiley is a well known component suitable for use with the electronic device of Yoshimura. One of ordinary skill in the art would have been motivated to make such a combination as it provides a way to monitor the voltage of batteries [Wiley: col.5, ll.18-29] in order to know the status of batteries.

18. As to claim 3, Wiley discloses an electronic device [electronic unit 50] comprising:

- The monitoring unit that that comprises a processor [CPU 111] supplied with digital information for evaluating the digital information to generate a signal indicating a supply status [table 1; service errors] representative of voltage information, and an externally

visible indicator [display 117 with display processor 116] connected to said processor for receiving said status signal therefrom and for displaying a visual indication of said supply status [col.5, ll.40-54; col.6, ll.29-46; col.8, l.66 – col.9, l.12; col.9, ll.34-57; col.15, ll.53-65].

19. It would have been obvious to one of ordinary skill in the art, having the teachings of Wiley and Yoshimura before him at the time the invention was made, to modify the electronic device taught by Yoshimura to include the monitoring unit taught by Wiley, in order to obtain the electronic device comprising the monitoring unit that that comprises a processor supplied with digital information for evaluating the digital information to generate a signal indicating a supply status representative of voltage information, and an externally visible indicator connected to said processor for receiving said status signal therefrom and for displaying a visual indication of said supply status. One of ordinary skill in the art would have been motivated to make such a combination as it provides a way to ensure an electronic device is in good working order [Wiley: col.1, l.14 – col.2, l.40].

20. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura as applied to claim 1 above, and further in view of Fang et al.; U.S. Patent 5128552, hereinafter Fang.

21. In re claim 12, Yoshimura disclose each and every limitation of the claim as disclosed above in reference to claim 1. Yoshimura did not discuss details of processing operations.

22. Fang discloses an electronic device [fig.1] comprising:

- A plurality of operating components [component 25; col.5, ll.25-38], and wherein a monitoring unit [25, 16] includes a processor [25d] for evaluating voltage information

[col.7, ll.13-31], and wherein said processor is connected to at least one of said operating components and alters operation of said at least one of said operating components if said voltage information indicates an unperformed need to replace a second battery [backup battery 22] [col.6, ll.7-58; col.7, ll.13-31; col.7, l.49 – col.8, l.8].

23. It would have been obvious to one of ordinary skill in the art, having the teachings of Fang and Yoshimura before him at the time the invention was made, to modify the electronic device taught by Yoshimura to include the monitoring unit taught by Fang, in order to obtain the monitoring unit that includes a processor for evaluating voltage information, and wherein said processor is connected to at least one of said operating components and alters operation of said at least one of said operating components if said voltage information indicates an unperformed need to replace a second battery. One of ordinary skill in the art would have been motivated to make such a combination as it provides a way to conserve battery power [Fang: col.3, ll.1-13; col.4, ll.11-13].

24. As to claim 13, Fang discloses the processor that prevents operation of said at least one operating component after a predetermined delay [T3] if said voltage information indicates an unperformed need to replace said second battery [col.6, ll.30-58].

Allowable Subject Matter

25. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

26. The following is a statement of reasons for the indication of allowable subject matter: the claims are allowable because none of the references cited, either alone or in combination,

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discloses or renders obvious an electronic device of claim 2, "wherein said analog-to-digital converter has a first input and a second input, and wherein said battery switchover device has an output, and wherein said device further comprises a first series circuit of Schottky diodes connected between said first input of said battery switchover device and said output, and a second series circuit of Schottky diodes connected between said second input of said battery switchover device and said output, said first series circuit having a center tap connected to said first input of said analog-to-digital converter and said second series circuit having a center tap connected to said second input of said analog-to-digital converter".

Response to Arguments

27. Applicant's amendment to claim 1 to overcome the previous rejection under 35 U.S.C. 112, first paragraph, has been fully considered. The amendment is in compliance with Examiner's position and the rejection is withdrawn.

28. Applicant's arguments filed on July 20, 2005 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

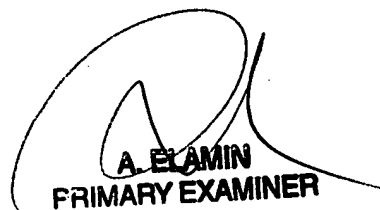
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tse Chen whose telephone number is (571) 272-3672. The examiner can normally be reached on Monday - Friday 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on (571) 272-3670. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tse Chen
August 11, 2005



A. ELAMIN
PRIMARY EXAMINER